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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/089,414	08/13/2002	Takashi Kanda	2000JP311	6991

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CLARIANT CORPORATION
ATTENTION; INDUSTRIAL PROPERTY DEPT.
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EXAMINER

LE, HOA VAN

ART UNIT PAPER NUMBER

1752

DATE MAILED: 04/26/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

AS

Office Action Summary

Application No.

10/089,414

Applicant(s)

KANDA, TAKASHI

Examiner

Hoa V. Le

Art Unit

1752

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory maximum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) See Continuation Sheet is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-4 and 6-8 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-9 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 13 August 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. ____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>28 May 2002</u> . | 6) <input type="checkbox"/> Other: ____ |

Continuation of Disposition of Claims: Claims withdrawn from consideration are (5 and 9) and (4 with respect to Kaiser et al (6,090,772).

This application is before the examiner for consideration.

A. Claims 1-9 are generic to a plurality of disclosed patentably distinct species comprising many possible surfactants of (the general compounds, such as N-acylsarcosinate) as disclosed in claim 1 in the art. Applicant is required under 35 U.S.C. 121 to elect a single disclosed surfactant species for an initiation of a search, even though this requirement is traversed. Applicant is further required to elect (sub-surfactant, such as N-lauroylsarcosinate) of the elected general compound.

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

B. Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 1-8, drawn to an aqueous anionic, nonionic or anionic-nonionic mixture surface active agents containing being conventionally known for their function as cleaning or detergent composition, classified in at least class 510, subclass 405, 409, 411, 413, 421 and class 430, subclass 331.

II. Claim 9, drawn to a method of washing out an unwanted material from a stable surface, classified in at least class (430, subclasses at least 325 and 326 un-hardening or soft material after a radiation exposure) and class (134, subclasses 1.3 and 34 dirt or oily material.

Inventions Group I and Group II are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case, the liquid detergent composition as claimed can be used to at least wash clothes, automobiles or glass windows and to clean porcelain toilets or table tops. Applicants are urged to show or provide an evidence to the contrary. In the absence of convincing evidence, the restriction on the record would not be removed.

Because these inventions are distinct for the reasons given above and have acquired the separate status and searches in the art and can be supported the separate patents as divided by applicants and have no evidence of the record that are not required the separate consideration and search since they are the obvious variants because the prior art being applied to one of them would be sufficient against all inventions, restriction for examination purposes as indicated is proper. Applicant should show or provide an evidence to the contrary. In the absence of convincing evidence, the restriction would not be removed.

However any process claim is permitted to be rejoined with a material claim provided (a) that the material claim is allowable and (b) the process claim must be contained all of the limitations of the allowable material claim in accordance with the authority stated in *In re Ochiai*, 37 USPQ2d 1127 or *In re Brouwer*, 37 USPQ2d 1663 and MPEP 821.04.

During a telephone conversation with Mr. Allen Kass on 16 April 2004 a provisional election was made with traverse to prosecute the invention of Group I, claims 1-8. Affirmation of this election must be made by applicant in replying to this Office action. Claim 9 is withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

C. Mr. Kass also elect N-lauroylsarcosinate species on 16 April 2004.

D. Applicant's prior art submission filed on 28 May 2002 has been considered to the extent of the English language as provided only.

E. The elected N-lauroylsarcosinate species has been considered and searched. The consideration and search are extended to the applied species. Other species have not been considered, searched or examined until all of the elected and applied species are overcome.

(1) Kaiser et al (6,090,772) is not applied on any species in claims 4 and 5. Accordingly, claims 4 and 5 are withdrawn at present time. (2) Glenn, Jr. et al (6,080,707) is not applied on any

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species in claim 5. Accordingly, claim 5 is withdrawn at present time. One (claim 5) or more (both claims 4 and 5) may be up for consideration and search when all of the applied species on the record are overcome if no more species is found and applied. No new consideration or search will be made after a final office action is issued. Applicant is now notified for the record.

F. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3 and 6-8 are rejected under 35 U.S.C. 102(b) as being anticipated by Kaiser et al (6,090,772).

Kaiser et al disclose, teach, demonstrate and reduce to practice an aqueous composition comprising ammonium lauroylsarcosinate and water. Please see Example 1, especially at col.7:27-44. The intended use in the preamble of the claims has and is given no value in the above statute. Since Kaiser et al disclose, teach, demonstrate and reduce to practice with the composition as claimed, the above claims are found to be anticipated by Kaiser et al.

G. Claims 1-4 and 6-8 are rejected under 35 U.S.C. 102(b) as being anticipated by Glenn, Jr. et al (6,080,707).

Glenn, Jr. et al disclose, teach, demonstrate and reduce to practice an aqueous composition comprising sodium or TEA (being known in the art as triethanolamine) lauroylsarcosinate and water. Please see Comparative Examples #6 and #7, especially at

col.17:39 to 18:9. The intended use in the preamble of the claims has and is given no value in the above statute. Since Kaiser et al disclose, teach, demonstrate and reduce to practice with the composition as claimed, the above claims are found to be anticipated by Kaiser et al.

H. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hoa V. Le whose telephone number is 571-272-1332.

The examiner can normally be reached from 6:00 AM to 4:00 PM on Monday through Thursday and about the same time of most Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark F. Huff can be reached on 571-272-1385

Applicants may file a paper by (1) fax with a central facsimile receiving number 703-872-9306,

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Hoa V. Le
Primary Examiner
Art Unit 1752

HVL
20 April 2004

HOA VAN LE
PRIMARY EXAMINER

